

REMARKS

In response to the restriction requirement stated in the Official Action dated October 5, 2005, Applicant provisionally elects claim Group I drawn to claims 1-25 and 42-46, with traverse.

Applicant has amended the claims to more particularly distinguish the invention. Claims 1 and 26, the independent claims, each now recite the features where:

at least two contact strips (5) are joined together in one contacting frame, the contacting frame being arranged to receive and hold the work piece (1) in a treatment tank (4).

Applicant respectfully traverses the outstanding requirement for restriction, and respectfully requests that it be withdrawn for the following reasons.

Applicant maintains that the relationship among the apparatus (claim Group I) and the processing method (claim Group II) is a close one. The restriction requirement has required electing “a single invention to which the claims must be restricted”, *i.e.*, either to the Group I claims 1-25 and 42-46 which are drawn to a device for electrolytically treating an at least superficially electrically conducting work piece, or to the Group II claims 26-41 and 47-52 which are drawn to a method for electrolytically treating an at least superficially electrically conducting work piece. The basis for the restriction, set forth in the Office Action appears to be that the Examiner has argued that the ISR would have shown that the special technical features of Groups I and II would allegedly not be novel or inventive, and that, accordingly, “the structural elements of the device of Group I and the method steps of Group II would have separate technical features (...) that would make them novel or inventive”.

First, in view of the current claim amendments, Applicant submits that features are contained in both claim groups and therefore should be examined together.

Second, the fact that the claims of the different claim groups may be in separate classes or subclasses does not of itself warrant restriction, since the purpose of classifying patents is not to establish lines of division between claims, and the Patent Office classification does not necessarily follow the lines established by manufacturers and inventors.

As the M.P.E.P. Section 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Inclusion of more than one claim group in this application would appear to promote purposes of economic efficiency, for both the Patent Office and the Applicant. This is particularly so here, where the search for either claim group would appear to also cover the other claim group.

Reconsideration and a withdrawal of the restriction requirement is hereby respectfully requested in view of the above amendments and the foregoing remarks.


If necessary, an appropriate extension of time to respond is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required to the Patent Office Deposit Account No. 05-0208.

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Respectfully submitted,
HARDING, EARLEY, FOLLMER & FRAILEY
Attorneys for Applicant



Frank J. Bonini, Jr.

Registration No. 35,452

P. O. Box 750

Valley Forge, PA 19482-0750

Telephone: 610-935-2300

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